

Docket No.: 5244-0051-2X DIV



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

Tetsuro MOTOYAMA

: GROUP ART UNIT: 2152

SERIAL NO: 08/738,659

2nd CPA FILED: MAY 11, 2001

: EXAMINER: LUU, L.

FOR: METHOD AND SYSTEM FOR
TRANSMITTING INFORMATION
FROM SENSORS USING ELECTRONIC MAIL

RECEIVED

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REPLY BRIEF

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

This reply brief is response to the Examiner's Answer mailed November 19, 2001.

The original Appeal Brief points to errors of the Examiner's rejection. The Examiner has attempted to address these errors in the Examiner's Answer, but the statements made by the Examiner do not explain away the errors in the Examiner's Rejection. The arguments contained herein directly address the Examiner's explanations.

Beginning at the top of page 11 of the Examiner's Answer, the Examiner outlines the reasons why the rejections including the combination of Kraslavsky et al and Cohn et al are believed by the Examiner to be proper. The issues and explanations provided by the Examiner's Answer show that the Examiner has taken in a hodgepodge fashion, teachings from the two patents, and combined them in a manner which would attempt to achieve the present invention, without sufficient motivation or explanation, and ignoring the primary

teachings and purposes of the references. This ignoring of important teachings of the patents is evident from the explanations set forth below.

1. Email Is Too Slow and Not Interactive Enough To Be Utilized In The System of Kraslavsky

As explained in the original Appeal Brief and supported by the Declaration of Tolsdorf, Jr., at the time of this invention, email was too slow and not interactive enough to be utilized in the system of Kraslavsky et al. In response to this argument, the Examiner emphasizes on p. 11 of the Examiner's Answer, using an underlined font, that neither Kraslavsky et al nor Cohn et al support the concept that email is too slow and not interactive enough to be utilized in Kraslavsky et al's system. However, the Examiner's explanation does not overcome or truly address the deficiencies of the rejection.

First, Kraslavsky et al have no teachings whatsoever regarding the use of email, so there cannot be any explanation that email is too slow and not interactive enough. Second, with regard to Cohn et al, it is not disputed that Cohn et al do not explain the various deficiencies of email which were in existence during the effective date of Cohn et al. However, this does not mean that such deficiencies including a lack of speed and a lack of interactiveness did not exist in Internet email.

Anybody who used and was familiar with Internet mail at the time of, or prior to the present invention would realize that it was not a suitable or obvious choice for a communication medium for an interactive print server such as that disclosed in Kraslavsky et al. The fact that Cohen et al may use email to communicate messages between people does not mean that email is a suitable communication medium for a print server. The applicant has presented evidence in the form of the Tolsdorf, Jr. Declaration explaining that email is not interactive or fast enough, and the Examiner has not presented any rebuttal evidence or even any logically supported arguments as to why Internet email may be interactive enough to use

as a communication medium for a print server. For at least this reason, the rejection should be reversed.

A premise of the above argument is that Kraslavsky et al require fast interactive communication. The Examiner does not acknowledge or accept that Kraslavsky et al has as an essential purpose to be interactive, and provide real-time or near real-time status and communication information. Below is an explanation and review of Kraslavsky et al to show interactive and near real-time communication is essential to the teachings of this patent.

(1) In the Field of the Invention section, Kraslavsky et al explains that the present invention is “for providing a bi-directional interface between a local area network and a peripheral.” Col. 1, lines 20-23. This bi-directional communication in the disclosed context of Kraslavsky is interactivity which is an essential part of Kraslavsky et al. In Kraslavsky et al, there is a Network Expansion Board (“NEB”) 2 incorporated into and coupled with the printer 4. See e.g. col. 4, lines 16-18 and Figure 4 which shows the printer 4 and NEB 2. It is clear that quite important to the system of Kraslavsky et al is the need to have communication between the network and printer on a near real-time basis. (“This multi-tasking processing ensures that the NEB is responsive to both the network and the printer on a near real-time basis.” col. 16, lines 9-11). Such an operation is consistent with the problem that the system of Kraslavsky et al attempts to overcome. Specifically, the Background section of Kraslavsky et al talks about the problems of prior art devices, none of which “provides a bi-directional interface between the printer and the network which allows the printer to export a large quantity of very specific printer status data to the network.” Kraslavsky et al at col. 1, lines 64-67. If Kraslavsky et al were modified to use email, as explained by the Examiner, the system would operate worse than the prior art systems that Kraslavsky et al were trying to improve upon, and destroy an essential purpose of Kraslavsky et al, something not permitted under U.S. law.

(2) Columns 14 and 15 describe the customized software used with the system of Kraslavsky et al. There are routines such as CPCONSOL, CPSOCKET, and CPINIT. These routines are generally described at columns 14 and 15. More specifically, CPINIT is used to "configure the NEB to act as a print server with one attached printer and specifies its primary file server." Col. 15, lines 23-25. A print server clearly requires rapid interactive communication with the printer to ensure a proper controlling and monitoring of printers. Rapid interactive communications is contrary to the use of email.

(3) Beginning at line 9 of column 26 in section 4C of Kraslavsky et al., the bi-directional interface between the local area network and the printer is described. The need for bi-directional communication over the local area network to the printer is set forth and is clearly an essential part of Kraslavsky et al.

(4) At col. 16, lines 9-11 of Kraslavsky et al., there is described the need of the NEB to be responsive on a near real-time basis. Such near real-time responsiveness could not be achieved by Internet email at the time of the invention.

(5) Still further, beginning at column 55, line 30, there is described in Kraslavsky et al. that the NEB needs to wait for a program for approximately 1 second. Internet email surely cannot have been expected to operate or be transmitted in this timeframe back at the effective date of Kraslavsky et al. (November of 1992).

It is possible to go on and cite further portions of Kraslavsky et al. for the need for interactive and bi-directional communication (which cannot be provided by email at the time of the present invention). However, the above examples are believed to be sufficient to make the point that interactivity is an essential feature of Kraslavsky et al.

Now that it has been established that interactivity and speed are an essential feature of Kraslavsky et al., the question is whether the combination of Cohn et al. into Kraslavsky et al. would destroy such interactivity and speed which are required in Kraslavsky et al. Going

back in time to the effective date of Kraslavsky et al and Cohn et al, and/or the time of Applicant's invention, email was slow and not interactive between its end users. This is generally known, and to provide support for such knowledge, the Declaration of Tolsdorf, Jr. has been presented which the Examiner has not rebutted.¹ As shown above, as interactive bi-directional communication is an essential teaching of Kraslavsky et al, and combining Kraslavsky et al with Cohn et al destroys an essential purpose of Kraslavsky et al.

For at least the reason that it is clearly an essential feature of Kraslavsky et al to have rapid bi-directional communication, and the fact that at the time of the invention, this was not possible using Internet email, Kraslavsky et al and Cohn et al could not be combined to achieve the present invention, and therefore the rejection must be reversed.

2. Kraslavsky et al Do Not Have Diverse Message Types

With regard to the point numbered by the Examiner as D-2, the Examiner has pointed out at p. 12 of the Examiner's Answer that Kraslavsky et al discloses the use of different network protocols (e.g., SPX/IPX, TCP/IP, and AppleTalk). However, the system of Kraslavsky et al is not disclosed as using these three network protocols simultaneously, or at different parts of a single system, but describes their use in the alternative (e.g., the system will use only one of the listed network protocols). If one of ordinary skill in the art were to study the teachings of Kraslavsky et al, this person would not apply the teachings of Cohn et al related to a standard message wrapper because the use in a single operating system of different message formats or protocols makes the standard message wrapper irrelevant to the system of Kraslavsky et al.

¹ Moreover, according to one embodiment of the present invention (e.g. not every embodiment) such as Claims 18 and 44, the inventor envisioned using a faster mode of communication than email for communications having a higher urgency than others. Thus, even before the Examiner made any rejection, the inventor envisioned an embodiment in which a communication mode faster than conventional Internet email could be utilized when there was some urgency or desire to communicate faster.

Moreover, the Examiner explains that TCP/IP supports Internet electronic mail. See the middle portion of p. 12 of the Examiner's Answer. Merely because it is possible for TCP/IP to support Internet electronic mail does not mean that the disclosure of TCP/IP discloses or suggests in any manner that Internet electronic mail should be used or is used in Kraslavsky et al. A reading of the Examiner's response to the argument labeled D-2 shows that the Examiner believes that Kraslavsky et al supports the use of Internet electronic mail, something which is explained throughout this Reply Brief and the Appeal Brief as being completely untrue.

3. **The Global Transfer of Messages is Not Sufficient Motivation.**

It was pointed out at the top of page 11 of the Appeal Brief that an explanation of the global communication should be provided. What the Examiner has set forth on pages 12-14 of the Examiner's Answer is that the combination of Kraslavsky et al and Cohn et al is desirable because it would allow the message to be transferred globally between any devices. See e.g., the top of p. 14 of the Examiner's Answer. It has been previously questioned as global communication between what devices? The devices in Kraslavsky et al can communicate well without the use of email as there already exists an arrangement for appropriate communications between devices. The Examiner does not adequately explain what global devices are in Kraslavsky et al's system or would need such global communication. At the middle portion of page 14 of the Examiner's Answer, the Examiner explains that Cohn et al teach the use of the Internet email to communicate various types of messages such as voice mail, electronic mail, facsimile transmissions, and video transmissions. However, Kraslavsky et al solely relates to the implementation of printer server functions into a NEB which is disposed within the printer. These messages are solely for communicating computer information, whereas video messages, facsimile transmissions,

etc. are for communicating between end users. Thus, achieving global communication in the system of Kraslavsky et al is certainly not a rational need, desire, or motivation for modifying Kraslavsky et al.

4. **It is Not Clear From the Rejection How the Combined System of Kraslavsky et al and Cohn et al Would Operate**

The Examiner's Answer has not addressed the issues raised in the Appeal Brief with regard to how the combined system would operate. A basic argument made in the Appeal Brief at p. 11 is that as Cohn et al teaches that a standard message wrapper would encapsulate all messages. If the teachings of Cohn et al were applied to Kraslavsky et al, all communications between the printer and the controlling computer would have an Internet electronic mail message format. As explained in the Appeal Brief and in the Tolsdorf, Jr. Declaration, such a system does not make sense, as all data transmitted to the printer would use Internet electronic mail.

The Examiner's Answer does not address this issue. What is stated at the bottom of page 13 and the top of page 14 is that it would have been obvious to combine the teachings of Kraslavsky et al and Cohn et al to use an Internet electronic mail message format to communicate between Kraslavsky et al's monitor and monitoring devices because it would allow the message to be transferred globally. If all message were encapsulated in a common wrapper, as explained in Cohn et al, with this feature applied to Kraslavsky et al the system would not make any sense because print data would not be transmitted to a printer or a print server using electronic mail.

For at least this reason, the rejection using the combination of Kraslavsky et al and Cohn et al is erroneous and should be reversed.

5. Claims 18 and 44

With regard to the argument beginning at the middle portion of page 15 of the Examiner's Answer with regard to Claims 18 and 44, the Examiner's arguments are pure hindsight and have nothing to do with the teachings of a combination taught by the prior art. Claims 18 and 44 recite specific manners of transmitting information using a connection-mode message when there exists static information which is outside of normal operating parameters. The Examiner appears to be stating that Internet electronic mail is a connection-mode message, as claimed. However, this certainly is not the case. Throughout the specification, it is evident that Internet electronic mail is not considered to be a connection-mode transmission because there is not a direct connection established between the first computer sending the Internet electronic mail and the final user which receives the electronic mail. Instead, the message is hopped throughout a plurality of servers on the Internet without a connection being established between the originator of the email and the receiver of the email. There simply is no teaching in any prior art of record of an Internet email being a connection mode message, as claimed.

Thus, as the prior art does not teach both the use of Internet electronic mail and a connection-mode message as claimed, Claims 18 and 44 are patentable and the rejection of these claims should be reversed.

6. Long-Felt But Unresolved Need

With regard to the issue of long-felt but unresolved need, the Declaration submitted by Motoyama explains, using objective evidence, examples of prior art attempts to provide an inexpensive remote monitoring and/or diagnostic system. While not completely clear from the Examiner's arguments at the bottom half of page 16 of the Examiner's Answer, it appears that the Examiner is arguing at the time of the invention of Motoyama, there was not an

unresolved need for reduced cost remote diagnosis and/or control and/or monitoring of office devices such as business office devices which include copiers, printers, facsimile machines, and the like. The Examiner points to the two patents utilized to reject the claims to support his assertion that there does not exist an unresolved need. The majority of the Examiner's explanation of how the need explained in the Motoyama Declaration has already been resolved is based on Cohn et al. The Examiner specifically states, "any electronic mail message has at least control information that is being used by the source and destination message systems." However, the Examiner has clearly ignored the claim limitations reciting what needs to be transmitted using electronic mail. For example, in Claim 10, there is recited information including a request for status of the monitored device determined using sensors within the monitored device. This information is then transmitted through electronic mail from the monitoring device to the monitored device. Assuming the Examiner is correct that some sort of control information related to the transmission of the email is sent, such control information has nothing to do with the monitored device and information from sensors. Moreover, the fact that Kraslavsky et al teaches the use of TCP/IP (but not in an Internet electronic mail context) has nothing to do with electronic mail.

From what the Examiner has presented, it is clear that no reference shows or explains that the issue of long-felt but unresolved need was solved prior to this invention. Therefore, there exists long-felt but unresolved need which the Examiner cannot simply ignore or choose to say does not exist, and this need is solved by the present invention. Thus, should there exist a prima facie case of obviousness, it should be withdrawn based on the presented evidence of a long felt but unresolved need.

Based on what has been presented above, there are numerous deficiencies in the Examiner's rationale and the rejections set forth by the Examiner should be reversed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



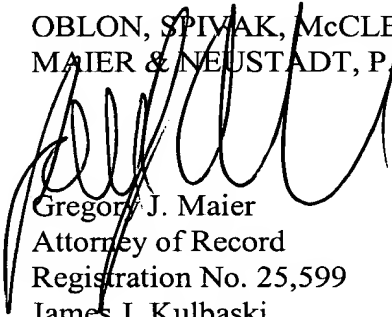
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